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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/827,870	04/06/2001	John F. Acres	4164-168	6066

7590

01/12/2004

MARGER JOHNSON & McCOLLOM, P.C.  
1030 S.W. Morrison Street  
Portland, OR 97205

EXAMINER

HARRISON, JESSICA

ART UNIT

PAPER NUMBER

3714

DATE MAILED: 01/12/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/827,870

Applicant(s)

ACRES ET AL.

Examiner

Jessica J. Harrison

Art Unit

3714

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 27 October 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 19,20,62-67,77-98 is/are pending in the application.
- 4a) Of the above claim(s) 19 and 20 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 88-98 is/are allowed.
- 6) ☒ Claim(s) 62-67 and 77-87 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 19 and 20 are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 06 April 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. §§ 119 and 120**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
- a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☒ Other: *See Continuation Sheet*.

Continuation of Attachment(s) 6). Other: PTO/SB/81 and OG Notice 01July2003.

**DETAILED ACTION**

***Terminal Disclaimer***

The terminal disclaimer filed on October 27, 2003 disclaiming the terminal portion of any patent granted on this application which would extend beyond the expiration date of US Pat. Nos. 5,655,961 and 5,836,817 has been reviewed and is NOT accepted.

The person who signed the terminal disclaimer is not recognized as an officer of the assignee, and he/she has not been established as being authorized to act on behalf of the assignee. See MPEP § 324.

An attorney or agent, not of record, is not authorized to sign a terminal disclaimer in the capacity as an attorney or agent acting in a representative capacity as provided by 37 CFR 1.34 (a). See 37 CFR 1.321(b) and/or (c).

Specifically, while Ms. Brooks does appear listed with the customer number of the firm, she is not listed as having a power of attorney with the instant file. A power of attorney in Ms. Brooks favor should be filed. The inventors may execute a power of attorney, the assignee may execute a power (note this option requires a proper 37 CFR 3.73(b) form in addition to the power), or someone of record on the originally filed power of attorney may execute an associate power of attorney in favor of Ms. Brooks. Included is a recent OG Notice regarding the elimination of Batch Update Practice in changing Power of Attorney, as well as a PTO/SB/81 form (Power of Attorney and Correspondence Address Indication Form) for applicant's review/convenience.

As the submitted Terminal Disclaimer is unacceptable at this time, the previously applied rejections under double patenting are repeated hereinbelow.

### ***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321© may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 77, 78 and 79 at least are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over

claims 1, 6 and 7 of U.S. Patent No. 5,655,961. Although the conflicting claims are not identical, they are not patentably distinct from each other because the differences comprise minor semantical differences, rephrasings, and omissions of non-critical subject matter. For example, the instant claims deletes "over the network" from the monitoring step, and adds that the payout table is stored in the device. Patent step activating is rephrases as initiating in the instant claim.

Claims 62-64, 66 and 67 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 24-26, 28 and 29 of U.S. Patent No. 5,836,817. Although the conflicting claims are not identical, they are not patentably distinct from each other because the only difference is a minor rephrasing. In the application, the "initiating a bonus period" step has been deleted and incorporated into the transmitting step with "transmitting...only if a bonus period has been initiated". The remaining claims are identical .

### ***Interference***

It is noted that applicant has copied claims from US Patent 5,885,158 for the purpose of provoking an Interference. The copied claims are newly added claims 88-98. Applicant has submitted a proposed count, defined the claims corresponding to the proposed count, applied the terms of the proposed count to the disclosure of the application, and satisfied the requirements of 35 USC 135(b), 37 CFR 1.607(b) and 37 CFR 1.608(a). It appears as though claims 88-98 are patentable to applicant. Pending resolution of the above outstanding rejection, Interference will be considered. As US Patent 5,885,158 appears to be undergoing Reexamination Proceedings, suspension of action herein will be entertained as the outcome of the Reexamination Proceeding will have direct bearing upon any declaration of Interference.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jessica J. Harrison whose telephone number is 703-308-2217. The examiner can normally be reached on 8 hour/M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tom Hughes can be reached on 703-308-1806. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9302.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0858.

A handwritten signature in black ink, appearing to read 'J. Harrison', written over the printed name.

Jessica J. Harrison  
Primary Examiner  
Art Unit 3714

jjh

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

**POWER OF ATTORNEY  
and  
CORRESPONDENCE ADDRESS  
INDICATION FORM**

Application Number	
Filing Date	
First Named Inventor	
Title	
Art Unit	
Examiner Name	
Attorney Docket Number	

I hereby appoint:

☐ Practitioners associated with the Customer Number:

OR

☐ Practitioner(s) named below:

Name	Registration Number

as my/our attorney(s) or agent(s) to prosecute the application identified above, and to transact all business in the United States Patent and Trademark Office connected therewith.

Please recognize or change the correspondence address for the above-identified application to:

☐ The address associated with the above-mentioned Customer Number:

OR

☐ The address associated with Customer Number:

OR

☐ Firm or Individual Name

Address

Address

City

State

Zip

Country

Telephone

Fax

I am the:

☐ Applicant/Inventor.☐ Assignee of record of the entire interest. See 37 CFR 3.71.  
Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96)**SIGNATURE of Applicant or Assignee of Record**

Name

Signature

Date

Telephone

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below\*.

☐ \*Total of \_\_\_\_\_ forms are submitted.

This collection of information is required by 37 CFR 1.31 and 1.33. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.14. This collection is estimated to take 3 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.

**United States Patent and Trademark Office OG Notices: 01 July 2003**Notice of Elimination of  
Batch Update Practice to  
Change Power of Attorney

Effective immediately, the ability to use a "batch update" to change powers of attorney is discontinued. A batch update is a procedure to request a change in the Office records for a batch of patent applications by submitting a spreadsheet listing the applications on a disk or a CD. With this process, a patent attorney or patent agent of record in each of the applications (or the pro se applicant of each of the applications on the spreadsheet) can request that the address associated with a "Customer Number" be used for the correspondence address and/or the fee address for the patent applications listed on the spreadsheet. Until now, an applicant could also indicate when a list of practitioners associated with a Customer Number should be used for the practitioners of record for the patent applications listed on the spreadsheet. Manual of Patent Examining Procedure (8th ed.2001) (Rev. 1, Feb. 2003), Section 403, Customer Number Practice, will be revised to reflect this change in practice.

Where the power of attorney (signed by the applicant or the assignee of the entire interest) is to the practitioners associated with a Customer Number (e.g., where PTO/SB/81 was used), the Office will continue to process a "Request for a Customer Number Data Change" (PTO/SB/124) to change the practitioners associated with the Customer Number, and as a result, the list of patent attorneys or agents having a power of attorney for the application. Furthermore, where the correspondence address for an application is the address associated with a Customer Number (e.g., where PTO/SB/121, Correspondence Address Indication form, was used), the Office will continue to process a "Request for a Customer Number Data Change" (PTO/SB/124) to change the address associated with the Customer Number, and as a result, the correspondence address for the application.

The batch update process will continue to be permitted for making changes in the correspondence address and the fee address in patent applications. Any batch update request that has been filed, but has not been processed, will be processed without changing the power of attorney (i.e., only a correspondence address and/or fee address will be changed). To change the power of attorney for the applications on the list, the batch update requestor will be instructed to submit a separate request to change a power of attorney (to the attorneys associated with a Customer Number) in each application on the spreadsheet. Forms PTO/SB/81, Power of Attorney, and PTO/SB/82, Revocation/Appointment of Power of Attorney, may be used to submit such a request.

Questions regarding batch updates or Customer Number practice should be directed to the Electronic Business Center by telephone to 866-217-9197 (toll-free), 703-305-3028, 703-308-6845 or by e-mail to [ebc@uspto.gov](mailto:ebc@uspto.gov).

June 5, 2003

NICHOLAS P. GODICI  
Commissioner for Patents